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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,316	04/02/2001	Mark D. Austin	BS01-058	7343

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EXAMINER
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CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/822,316

Applicant(s)

AUSTIN &amp; JABARRY

Examiner

WILLIAM D CUMMING

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11 and 21-32, drawn to a telecommunication method for a radio telephone system being a zoned or cellular system comprising a handoff with mobile assisted or initiated, classified in class 455, subclass 431.
- II. Claims 12-20, drawn to a telecommunication method for a radio telephone system being a zoned or cellular system comprising a handoff with the handoff initiated by another source, classified in class 455, subclass 439.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as a handoff method wherein the mobile station plays a role in the determination of the new serving base station. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Drawings***

#### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

##### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

### **Annotated Drawing Sheets**

**A marked-up copy of any amended drawing figure, including annotations indicating the changes made, is required by the examiner.** The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### **Conclusion**

#### **All Electronic Copies of Patent Application Records Will Now Be Provided as Certified Copies in Electronic Form**

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For the last two years certified copies of large patent application files produced from the USPTO's electronic systems have been provided only on compact disc, with an attached paper certification statement. Currently, certified

copies of patent applications as filed of 400 or more pages and all certified File Wrapper copies produced from IFW are provided on compact disc (CD), both with attached paper certification statements. The \$200 fee for a file wrapper and contents was effectively waived and replaced by a \$55 fee when the application contents are provided on CD. See Copies of File Contents Available on Compact Disc Partial Waiver of 37 CFR 1.19(b), 1278 Off. Gaz. Patent Office 261 (Jan. 27, 2004). The fee for an application as filed remains \$20, as set forth in 37 CFR 1.19(b)(1), even when the copy is provided on compact disc.

**Effective July 30, 2004, all copies of patent documents purchased under 37 CFR 1.19 and produced from IFW will be provided only as electronic files, with an imaged certification statement included as part of a digitally signed PDF (portable document format) file containing TIFF (tag image file format) images of the document pages. These electronic files may be downloaded from the USPTO website or provided by the USPTO on compact disc. The electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. As mentioned above, all copies purchased pursuant to 37 CFR 1.19 and produced from IFW will be produced only as certified copies. Uncertified copies may be downloaded under the USPTO's Public PAIR system.**

**Before submitting electronic certified copies of the application as filed supplied on CD or in another electronic form to intellectual property offices under Article 4 of the Paris Convention for the Protection of Industrial Property applicants should inquire whether that office accepts priority documents in electronic form. Although the USPTO provides a certified copy in electronic form, applicants may print the certified copies to paper if required by the intellectual property office to which it is submitted.**

The USPTO is actively engaging in discussions with other intellectual property offices for the mutual acceptance of electronic priority documents. Should another intellectual property office not accept a paper or electronic certified copy of a patent application as filed as described in the above paragraph, upon presentation of a notice of non-acceptance by the other office, the USPTO will provide a substitute paper copy with a letter signed by an official of the USPTO addressed to the foreign office indicating that the certified copy of the application as filed is to be accepted under **Article 4 of the Paris Convention for the Protection of Industrial Property**. Since the USPTO will no longer bind or rivet paper certified copies of patent applications as filed or file wrappers and contents, copies produced by the Office will be identical to copies printed by an applicant from the electronic certified

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D CUMMING** whose telephone number is 703-305-4394. The examiner can normally be reached on Monday 10:30am to 8:30pm, Tuesday 10:00am to 4:00pm and Wednesday 10:00am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **WILLIAM TROST** can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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